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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/756,750	01/14/2004	Charles Meehan	P08436US01/DEJ	1537
22204	7590	03/23/2005	EXAMINER	
NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128			PICKETT, JOHN G	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

8W

Office Action Summary

Application No.

10/756,750

Applicant(s)

MEEHAN ET AL.

Examiner

Gregory Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 31 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 31 recites the limitation "said closed configuration" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 5, 6, 8, 9, 16, 17, 22, 24, 25, 28-31, 33, and 35-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Kirkpatrick (US 838,031).

Regarding claim 1, Kirkpatrick discloses a convertible case (Figure 1) comprising a first shell **20, 21, 22 & 23**, a second shell **27 & 29**, and a hinge **25**. Kirkpatrick functions as claimed and is capable of receiving weight devices.

As to claim 2, the second shell is rotated as claimed (see Figure 1).

As to claims 5 and 6, Kirkpatrick discloses position-locking mechanism **32**, which is a rigid brace.

As to claim 8, Kirkpatrick discloses brace engagement mechanism **31**.

As to claim 9, Kirkpatrick discloses clasps **32**.

As to claim 16, Kirkpatrick discloses compartments in the second shell (see Figure 7).

As to claim 17, the weight devices are not positively claimed. As such, Kirkpatrick is capable of retaining dumbbells as claimed.

Regarding claim 22, Kirkpatrick discloses a convertible case (Figure 1) comprising a first shell **20, 21, 22 & 23**, a second shell **27 & 29**, a hinge **25**, a clasp **32**, and a position-locking mechanism **31**. Kirkpatrick functions as claimed and is capable of receiving weight devices.

As to claim 24, Kirkpatrick discloses compartments in the second shell (see Figure 7).

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As to claim 25, the weight devices are not positively claimed. As such, Kirkpatrick is capable of retaining dumbbells as claimed.

Regarding claim 28, Kirkpatrick discloses the provision of a convertible case (Figure 1) comprising a first shell **20, 21, 22 & 23**, a second shell **27 & 29**, a hinge **25**, and the rotation and angling of the first and second shells as claimed (see Figures 1-3).

As to claims 29 and 30, Kirkpatrick discloses locking in a rack configuration (see Figure 2) by means of position-locking mechanisms **31**.

As to claim 31, Kirkpatrick discloses clasps **32**.

As to claim 33, no further method step is claimed. However, Kirkpatrick discloses compartments in the second shell (see Figure 7).

Regarding claim 35, Kirkpatrick discloses a convertible case (Figure 1) comprising a first shell **20, 21, 22 & 23**, a second shell **27 & 29**, a clasp **32**, and a position-locking mechanism **31**. Kirkpatrick functions as claimed and is capable of receiving weight devices.

As to claim 36, Kirkpatrick discloses compartments in the second shell (see Figure 7).

As to claim 37, Kirkpatrick discloses hinge **25**.

4. Claims 35, 36, and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Yang (US 5,630,776).

Regarding claims 35 and 36, Yang discloses a convertible weight device case (Figure 1), with a first shell **12** with a plurality of compartments (cut-outs for dumbbells),

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a second shell **13** with a plurality of compartments (cut-outs for dumbbells), a clasp **11**, and a position locking mechanism **23**.

As to claim 38, Yang discloses a handle **10**.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 3, 4, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirkpatrick in view of Moog (US 754,227).

Regarding claims 3 and 4, Kirkpatrick discloses the claimed invention except for the specific angle between the shells. Moog discloses that it was known in the art to vary the angle between the components of a convertible display case. It would have

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been an obvious matter of design choice to provide the case of Kirkpatrick in the claimed angles.

Regarding claim 7, Kirkpatrick discloses the claimed invention except for the position-locking mechanism is a rigid bar instead of a strap or cord. Moog shows that position-locking straps **D & D'** were an equivalent structure known in the art. Therefore, because these two locking means were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the straps of Moog for the rigid brace of Kirkpatrick.

6. Claims 10-12, 18, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirkpatrick in view of CAP BARBELL RK-12 (http://www.capbarbell.com/products_template_commodity.htm).

The CAP BARBELL RK-12 Dumbbell rack shows that it was known in the art at the time the invention was made, in vertically stored dumbbell sets (including "A" Frame racks and the sets including a plurality of differing weights), to place the heavier weights at the bottom with dumbbells incrementally decreasing in size and weight as they were placed on the vertical rack. In such sets, it was known to provide the dumbbells in pairs on either side of the vertical rack, one for each of the user's hands.

Kirkpatrick discloses the claimed invention except for the different sized compartments. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the compartments of Kirkpatrick with vertically decreasing sized compartments, as taught by CAP BARBELL, in order to accommodate

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a complete dumbbell set. As the hinge of Kirkpatrick was located at the upper portion of the case, the smallest weights would have been located near the hinge with the sizes increasing away from the hinge.

7. Claims 13, 14, 23, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirkpatrick in view of Babbitt (US 1,086,746).

Regarding claims 13 and 14, Kirkpatrick, as applied to claim 1 above, discloses the claimed invention except for the handle.

Babbitt discloses a handle **5** to carry the convertible case. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Kirkpatrick with a handle as taught by Babbitt in order to assist in carrying the case; the location of the handle being an obvious matter of design choice.

Regarding claim 23, Kirkpatrick, as applied to claim 22 above, discloses the claimed invention except for the handle.

Babbitt discloses a handle **5** to carry the convertible case. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Kirkpatrick with a handle as taught by Babbitt in order to assist in carrying the case; the location of the handle being an obvious matter of design choice.

Regarding claim 38, Kirkpatrick, as applied to claim 35 above, discloses the claimed invention except for the handle.

Babbitt discloses a handle **5** to carry the convertible case. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide

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the case of Kirkpatrick with a handle as taught by Babbitt in order to assist in carrying the case.

8. Claims 15 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirkpatrick-Babbitt as applied to claim 13 above, and further in view of Bridges (US 4,930,628).

Regarding claim 15, Kirkpatrick-Babbitt discloses the claimed invention except for the handle integral with the hinge.

Bridges discloses a handle **15** integral with the hinge **23** on a convertible display case **1**. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the handle integral with the hinge as taught by Bridges in order to reduce the number of parts for assembly. It has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

As to claim 32, Kirkpatrick-Babbitt-Bridges, as applied to claim 15, discloses the claimed method.

9. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kirkpatrick.

The examiner takes Official Notice that it was common and conventional in the packaging art to offset cylindrical shaped objects in order to reduce the space requirements for storage.

Applicant, of course, has the right to challenge this Official Notice in response to this decision and demand production of evidence in support thereof, provided such challenge is accompanied by adequate information or argument that, on its face, creates a reasonable doubt regarding the circumstances justifying the Official Notice. See In Re Boon, 439 F.2d 724, 169 USPQ 231, 234 (CCPA 1971).

Kirkpatrick discloses the claimed invention except for the offset compartments. It would have been obvious to one of ordinary skill in the art at the time the invention was made to offset the compartments of Kirkpatrick, as was common practice in the art, in order to reduce the thickness of the case.

10. Claims 20, 21, 27, 34, and 39 rejected under 35 U.S.C. 103(a) as being unpatentable over Kirkpatrick in view of Bushnell (US 4,477,074).

Regarding claim 20, Kirkpatrick discloses the claimed invention except for the wheels.

Bushnell discloses wheels **33** on a portable rack. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Kirkpatrick with wheels as taught by Bushnell in order to assist in transporting larger, heavier items.

As to claim 21, Bushnell discloses a handle 41 at an opposite end of the case from the wheels 33. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Kirkpatrick with a handle in order to enable the movement of the case on its wheels (Bushnell Col. 5, lines 34-42).

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Regarding claim 27, Kirkpatrick discloses the claimed invention except for the wheels.

Bushnell discloses wheels **33** on a portable rack. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Kirkpatrick with wheels as taught by Bushnell in order to assist in transporting larger, heavier items.

Regarding claim 34, Kirkpatrick discloses the claimed invention except for the wheels.

Bushnell discloses wheels **33** on a portable rack. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Kirkpatrick with wheels as taught by Bushnell in order to assist in transporting larger, heavier items.

Regarding claim 39, Kirkpatrick discloses the claimed invention except for the wheels.

Bushnell discloses wheels **33** on a portable rack. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Kirkpatrick with wheels as taught by Bushnell in order to assist in transporting larger, heavier items.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wu, Osborn, and Cordes disclose portable cases for exercise


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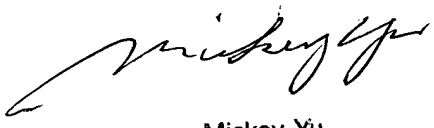
equipment. Smith, Mayer, Sr. et al, and Lurie et al disclose convertible display cases. Minneman discloses a convertible rack with a handle proximate to the hinge and offset retention brackets.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Greg Pickett
Examiner
18 March 2005


Mickey Yu
Supervisory Patent Examiner
Group 3700